

REMARKS

Claims 1 - 30 remain active in this application. The specification has been reviewed and editorial revisions made where seen to be appropriate including a typographical revision in claim 25. No new matter has been introduced into the application.

Restriction has been required between the inventions, as identified by the Examiner as being claimed in the following groups of claims:

Group I, claims 1 - 15, drawn to an arrangement for positioning an object;

Group II, claims 16 - 20 drawn to a method of reducing forces applied to an object; and

Group III, claims 21 - 30, drawn to an apparatus. The invention of Group I has been provisionally elected with traverse, above.

The requirement for restriction is respectfully traversed since the Examiner has not properly *prima facie* demonstrated either distinctness of the inventions identified or the existence of a serious burden of examination in the absence of the requirement. Specifically, the Examiner asserts that Groups I and II are unrelated and that Groups II and III are unrelated and that Groups I and III are related as combination and subcombination. It is respectfully submitted that a careful comparison of claims 1 and 21 of Groups I and III respectively reveals that both claims recite substantially the same combination of elements (the "mount", "holding element" and "variable assist clamp" of claim 22 generally corresponding to the "surface", first actuator and second actuator, respectively, of claim 1) having the same cooperation between them; the principal difference between the claims being that the elements comprising the invention are additionally related by comprising an "apparatus" in claim 21 whereas, in claim 1 the elements need not

be so associated. Similarly, a careful comparison of claims 1 or 21 with claim 16 of Group II will reveal that Groups I and II and Groups III and II are, indeed, related as mechanical structure and the operation of that mechanical structure and the two steps recited in claim 16, directly correspond to the recited functions of the first and second actuators of claim 1 and the holding element and variable assist clamp of claim 21. Therefore, it is clear that the Examiner is clearly in error in the discussion of independence and/or distinctness of the identified inventions since all of the identified inventions are clearly related, have the same mode of operation, function and effects and are clearly capable of being used together as well as claims 1 and 21 comprising substantially the same combination of elements. Therefore, the Examiner has not made a *prima facie* demonstration of distinctness or independence of the identified inventions.

By the same token, while the Examiner has indicated different classification of the three Groups of claims, the Examiner has made no assertion and given no indication that the searches appropriate to the subject matter of the claims would be other than substantially congruent rather than divergent or that there would be any required search area for any given Group where *no relevant prior art would be expected* for another of the Groups. Therefore, the Examiner has not made a *prima facie* demonstration of the existence of a serious burden of examination in the absence of the requirement.

Accordingly, since the requisite *prima facie* demonstrations of distinctness and/or serious burden have not been made, it is clear that the requirement for restriction is in error and without supporting basis in the subject matter of the respective claims. Therefore, it is respectfully requested that the requirement for restriction be reconsidered and

withdrawn and that an action be taken on the merits of the claims of all identified groups of claims.

The Examiner has also required election of species between:

Species I illustrated in Figures 1, 2A, 3, 4, 8, 9, 11 and 12;

Species II illustrated in Figures 5 - 7; and

Species III illustrated in Figures 14 - 17. This requirement for election of species is also respectfully traversed, particularly as being unclear as to the distinctions the Examiner considers to characterize the respective species.

It is respectfully submitted that the illustrations of various embodiments, variations of implementation and combination with perfecting features contain many features that differ between the respective Figures and even between the Figures identified by the Examiner as corresponding to a single species. Moreover, the combinations of Figures indicated by the Examiner are not consistent with the disclosure of various embodiments in the specification. Accordingly, it is difficult to determine what feature(s) the Examiner considers to differentiate the respective species which the Examiner has identified. Thus, as the requirement is understood by the undersigned, it appears that the identified species are differentiated by the manner in which the clamp element is supported. That is, in species I, the clamp element is carried by the transducer; in species II, the clamp element is pivoted; and in species III, the clamp element is carried by a thin, deflectable cantilever beam. This feature appears to be the only feature which is consistent within each group of Figures identified by the Examiner which consistently differing between the groups of Figures identified by the Examiner. If this understanding of the requirement is incorrect or incomplete, clarification of the

requirement and an opportunity to alter the provisional election made above is respectfully requested.

Based on the above understanding to the requirement, election of species I has been provisionally made, claims 1 - 10, 12 and 14 - 30 have been indicated as readable on the elected species and, while claim 1 has been indicated to be generic by the Examiner, it is respectfully submitted that claims 1 - 10 and 14 - 30 are considered to be generic to all the identified species. Only claims 12 - 14 are specific to respective species that the Examiner appears to have identified based on the above-noted differentiating feature. Therefore, it is respectfully submitted that there is no serious burden of examination in the absence of the requirement for election of species since only two dependent claims would be withdrawn from consideration regardless of the species elected and a search for all species should be required in view of generic claims and it appears likely that rejoinder will be required. It is also respectfully pointed out that no species-specific claims are presented in Groups II and III, discussed above. Accordingly, it is respectfully requested that the requirement for election of species be reconsidered and withdrawn.

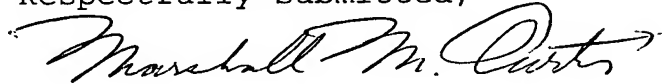
In summary, it is respectfully submitted that the requirement for restriction is in error and the requirement for election of species is not well-justified. Accordingly, withdrawal of either or both requirements and an action on the merits of all claims in the application is respectfully requested.

Since all requirements contained in the outstanding official action have been fully answered, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and an action on the merits of all claims in the application is respectfully requested. Upon reconsideration, it is also respectfully submitted that

this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Marshall M. Curtis".

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